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EXAMINER

LEROUX, ETIENNE PIERRE

ART UNIT	PAPER NUMBER
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2171

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/671,739

Applicant(s)

MOSKOWITZ ET AL.

Examiner

Etienne P LeRoux

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 23 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-61 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 7-10, 12-40, 51-53 and 55-61 are rejected under 35 U.S.C. 102(e) as being anticipated by US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268).

Regarding claim 1, Pat '268 discloses:

a first input that receives at least one reference signal to be monitored [Fig 6, owner digital content]

a first processor that creates an abstract of each reference signal input to said first processor through said first input [Fig 6, owner abstract]

a second input that receives at least one query signal to be analyzed [Fig 6, user digital content]

a second processor that creates an abstract of each query signal [Fig 6, user abstract]

a reference database that stores abstracts of each at least one reference signal [Fig 6, inherent]

a comparing device that compares an abstract of said at least one query signal to the abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts [Fig 6, compare]

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a device that permits submission of reference signal abstracts to the reference database [Fig 6, inherent]

Regarding claim 1, examiner maintains that in the referenced patent, Pat '268, that "a reference database that stores abstracts of each at least one reference signal" and "a device that permits submission of reference signal abstracts to the reference database" is inherent. Examiner notes, the MPEP § 2112.01 states "[w]here the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990)."

Regarding claim 3, Pat '268 discloses the reference database is available to the public [col 8, lines 15-18].

Regarding claim 7, Pat '268 discloses value-adding components [col 8, line 30].

Regarding claim 8, Pat '268 discloses the second input is remotely coupled to the system [Fig 6].

Regarding claim 9, Pat '268 discloses the second processor is remotely coupled to the system [Fig 6].

Regarding claim 10, Pat '268 discloses the system transmits criteria that as being used by the first processor to the second processor [Fig 6]

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Regarding claims 12, 26 and 33, Pat '268 discloses a certification authority [col 6, lines 19-36].

Regarding claims 13, 32 and 58, Pat '268 discloses:

a first input that receives at least one reference signal to be monitored [Fig 6, owner digital content]

a first processor that creates an abstract of each reference signal input to said first processor through said first input [Fig 6, owner abstract]

a second input that receives at least one query signal to be analyzed [Fig 6, user digital content]

a second processor that creates an abstract of each query signal [Fig 6, user abstract]

a reference database that stores abstracts of each at least one reference signal [Fig 6, inherent]

a comparing device that compares an abstract of said at least one query signal to the abstracts stored in the reference database to determine if the abstract of said at least one query signal matches any of the stored abstracts [Fig 6, compare]

means for linking/embedding the query signal abstract to the reference signal corresponding to the matching reference signal abstract [Fig 6, matching]

Regarding claim 14, Pat '268 discloses the linking is dependent on predetermined access rules [col 8, lines 15-20]

Regarding claim 15, Pat '268 discloses signal quality [col 3, lines 1-5].

Regarding claim 16, Pat '268 discloses a set of related abstracts for substantially the same signal [col 7, lines 24-33]

Regarding claim 17, Pat '268 discloses the abstract is distributed to a plurality of locations [col 1, lines 14-30]

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Regarding claim 18, Pat '268 discloses means for linking the query signal abstract to the reference signal is bi-directional [Fig 6, compare and col 8, lines 14-18]

Regarding claim 19, Pat '268 discloses electronic linking [col 1, lines 4-11]

Regarding claim 20, Pat '268 discloses access control [col 4, lines 36-39]

Regarding claim 21, Pat '268 discloses a public network [col 1, lines 14-22]

Regarding claim 22, Pat '268 discloses a means to monitor the comparison difference [Fig 6, match?]

Regarding claims 27 and 59, Pat '268 discloses embedding each reference signal with its corresponding reference signal [col 2, lines 1-15]

Regarding claims 28, 31, 35, 36 and 55, Pat '268 discloses the signal is hashed before it is embedded [Fig 5]

Regarding claims 29, 38 and 56, Pat '268 discloses the reference signal is digitally signed before it is embedded [Fig 5]

Regarding claim 30, Pat '268 discloses the matching signal abstract is downloadable [col 7, lines 34-41]

Regarding claims 34 and 39, Pat '268 discloses the abstract is embedded with a predetermined key [Fig 7]

Regarding claim 37 and 40, Pat '268 discloses the abstract is associated with a key [Fig 7]

Regarding claims 51-53, Pat '268 discloses a device for attaching the corresponding reference signal abstract to each reference signal [col 2, lines 1-5].

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Regarding claims 57 and 60 and 61, Pat '268 discloses determining an authorized signal  
[Fig 6, compare]

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 4 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above.

Regarding claim 4, Pat '268 discloses the essential elements of the claimed invention except for access to the database is limited to at least one of specific members of the public and specific companies. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include the database is limited to at least one of specific members of the public and specific companies for the purpose of marketing a service and therefore, requiring users to pay for the service provided.

Regarding claim 11, Pat '268 discloses the claimed invention except for creating and storing new abstracts. It would have been obvious at the time the invention was made to modify Pat '268 to include creating and storing new abstracts, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art.

*St Regis Paper Co. v. Bemis Co.*, 193 USPQ 8.

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5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above, and further in view of US Pat No. 6,199,058 issued to Wong et al (hereafter Pat '058).

Regarding claim 2, Pat '268 discloses suitable content members (Fig 6, owner content) but does not disclose a database report. Pat '058 discloses a database report (claim 13). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include a database report as taught by Pat '058 for the purpose of providing to a user the current status of the database.

6. Claims 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 1 above, and further in view of US 2002/0026343 issued to Duenke (hereafter Pat '343).

Regarding claim 5, Pat '268 discloses the essential elements of the claimed invention except for a report to determine database pricing. Pat '343 discloses a report to determine database pricing [paragraph 43]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include report to determine database pricing as taught by Pat '343 for the purpose of estimating construction costs [abstract].

Regarding claim 6, Pat '268 discloses the essential elements of the claimed invention except for the report is used to determine suitable content for a searchable index of content. Pat '343 discloses the report is used to determine suitable content for a searchable index of content. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include the report is used to determine suitable content for a searchable



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index of content as taught by Pat '343 for the purpose of overcoming learning difficulties [paragraph 42].

7. Claim 23 is are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 22 above, and further in view of US Pat No. 6,381,618 issued to Jones et al (hereafter Pat '618).

Regarding claim 23, Pat '268 discloses the essential elements of the claimed invention except for the comparison device is part of a web browser. Pat '618 discloses the comparison device is part of a web browser [col 5, lines 30-37]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat '268 to include the comparison device is art of a web browser as disclosed by Pat '618 for the purpose of determining whether the retrieved copy is a copy of a most recent version of the first document [abstract].

Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 22 above, and further in view of US Pat No. 5,884,033 issued to Duvall et al (hereafter Pat '033).

Regarding claim 24, Pat '268 discloses the essential elements of the claimed invention except for the comparison device is part of a filtering function. Pat '033 discloses the comparison device is part of a filtering function [Fig 4]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Pat 268 to include the

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comparison device is part of a filtering function as taught by Pat '033 for the purpose of deciding whether to block or allow incoming and/or outgoing transmissions of messages [abstract].

8. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) as applied to claim 23 above, in view of US Pat No. 6,381,618 issued to Jones et al (hereafter Pat '618) and further in view of US Pat No. 5,478,990 issued to Montanari et al (hereafter Pat '990).

Regarding claim 25, the combination of Pat 268 and Pat '618 discloses the essential elements of the claimed invention except for a means for non-owners of the reference database to submit signals to the reference database. Pat '990 discloses a means for non-owners of the reference database to submit signals to the reference database [col 11, lines 53-61]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Pat '268 and Pat '618 to include a means for non-owners of the reference database to submit signals to the reference database as taught by Pat '990 for the purpose of maintaining the database current and up-to-date.

9. Claims 41 and 54 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) in view of US Pat No. 6,457,058 issued to Ullum et al (hereafter Ullum '058).

Regarding claims 41 and 54, Pat '268 discloses the essential elements of the claimed invention except for a digital signal having a known distribution address. Ullum '058 discloses a digital signal having a known distribution address [abstract]. It would have been obvious to one

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of ordinary skill in the art at the time the invention was made to modify Pat '268 to include a digital signal having a known distribution address as taught by Ullum '058 for the purpose of improving RAM access [abstract]

10. Claims 42-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of US Pat. No. 6,230,268 issued to Miwa et al (hereafter Pat '268) and US Pat No. 6,457,058 issued to Ullum et al (hereafter Ullum '058) and further in view of US Pat. No. 5,920,900 issued to Poole et al (hereafter (Pat '900).

Regarding claims 42 and 43, the combination of Pat '268 and Pat '058 discloses the essential elements of the claimed invention except for distribution of the digital signal when the digital signal abstract does not match an abstract in the database. Pat '900 discloses distribution of the digital signal when the digital signal abstract does not match an abstract in the database [col 3, lines 23-25]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combination of Pat '268 and Pat '058 to include distribution of the digital signal when the digital signal abstract does not match an abstract in the database as taught by Pat '900 for the purpose of providing an efficient and low cost method of translation [col 3, lines 1-5].

Regarding claims 44 and 45, the combination of Pat '268 and Pat '058 discloses the essential elements of the claimed invention except for distribution of the digital signal when the digital signal abstract does match an abstract in the database. Pat '900 discloses distribution of the digital signal when the digital signal abstract does match an abstract in the database [col 3, lines 20-22]. It would have been obvious to one of ordinary skill in the art at the time the

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invention was made to modify the combination of Pat '268 and Pat '058 to include distribution of the digital signal when the digital signal abstract does match an abstract in the database as taught by Pat '900 for the purpose of providing an efficient and low cost method of translation [col 3, lines 1-5].

Regarding claim 46, examiner maintains "wherein the database is created by at least one of a music company, a movie studio, an image archive, and a combination thereof" is drawn to intended use and is not given patentable weight.

Regarding claim 47, Pat '268 discloses at least one of digital images, digital audio and digital video [col 1, lines 15-20].

Regarding claim 48, Pat '268 discloses copyright status [col 1, lines 14-16].

### ***Response to Arguments***

11. Applicant's arguments filed 9/23/03, have been fully considered but they are not persuasive.

Applicant states on page 13, "Moreover, Claim 1 requires 'a comparing device that compares an abstract of said at least one query signal to abstracts stored in the reference database to determine if the abstract of at least one query signal matches any of the stored abstracts.' The examiner asserts that this limitation is met by Figure 6 compare. As described above, Miwa discloses comparing 'an abstract .... prepared from a distributed token using a publicly opened key' to an 'an abstract similarly prepared from a distributed image to verify a match.' [...]

There is no reference to a database, and no reference to a query signal. Miwa fails to describe

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the comparison of an abstract of at least one query signal with abstracts stored in the reference database as required by claim 1.” Examiner is not persuaded.

Applicant’s assertion that there is no reference to a database is rebutted below. Miwa ‘268 discloses in column 8, lines 15-20, the following:

A system of generating a token using an asymmetrical key from an abstract made of a compressed image is shown in FIG. 6 as another embodiment of a copying control system in digital image distribution. The basic mechanism is same as the case where the one-way hash function is used. An important point in the case where a token is generated using an asymmetrical key lies in that the method of generating a token from an abstract is kept in secret while generation of an abstract from a token is open to public. **In the user side, an abstract is prepared from a distributed token using a publicly open key and compared with an abstract similarly prepared from a distributed image to verify the match.** Copying is inhibited when a token is valid despite the CF does not permit one time copying. Further, the token is disabled.

Examiner maintains that the abstract that is prepared from a distributed token at the user’s side is stored in a database at the user’s side. Similarly, the abstract that is prepared from the compressed digital content is also stored in the database at the user’s side. When the comparison is made between the above two abstracts, data is retrieved from the database in order to make the comparison. In particular, the comparison made (Fig 6, Compare step) between the abstract of the token with the abstract from the compressed digital content, the signals are selected from the above described database at the user’s side.

Examiner furthermore, maintains that the step “Compare” in Figure 6 of Miwa ‘268 requires the database to be queried in order to retrieve the two signals which are to be compared. Therefore, examiner concludes that Miwa ‘268 reads on the claim 1 limitations “a reference database that stores abstracts of each at least one reference signal; a comparing device that compares an abstract of said at least one query signal to the abstracts stored in the reference database to

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determine if the abstract of said at least one query signal matches any one of the stored abstracts.”

Applicant states on page 14, “As amended, Claim 7 depends from claim 2, and further requires that ‘the database rights and restrictions report is used to associate content with internal value adding components created by the rights holder.’ [ ..... ] Examiner fails to address the limitation of a database rights restriction report. In fact, the examiner explicitly states that ‘Regarding claim 2, Pat ‘268 .... does not disclose a database report.’ Office Action at 7. The examiner did not reject claim 2, from which claim 7 now depends, based on Section 102.” Examiner is not persuaded. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa ‘268 in view of Wong ‘058. Wong ‘058 discloses a database report [claim 13]. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wong ‘058 to include “a database rights and restriction report” per claim 2. The ordinarily skilled artisan would have been motivated to modify Miwa ‘268 per the above for the purpose of providing an owner with the privileges granted to his/her customers.

Applicant states on page 14, “Moreover, Miwa also fails to disclose “associat[ing] content with internal value adding components created by the rightsholder’ as required by claim 7. The examiner’s reference to Miwa, col 8, line 30 is inapposite as it describes the attachment

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of a token to electronic money and disabling the token when the money is paid. This gives no suggestion of 'associat[ing] content with internal value adding components created by the rightholder.'" Examiner is not persuaded. Applicant has misquoted the claim language of claim

7. Claim 7 includes "**external**" value adding components. Examiner maintains the claim limitation "external value adding components" is very broad and therefore, Miwa's disclosure in column 8, line 30 reads on above claim 7.

Applicant states on page 14, "Claims 12, 26 and 33 depend from claims 1, 13 and 32 respectively, and further require that 'the reference database acts as a certification authority.' [ ..... ] "Miwa fails to disclose a reference database -- much less a reference database that serves as a certification authority." Examiner is not persuaded. Applicant is referred to supra discussion of claim 1 regarding a reference database. Furthermore, Miwa '268 in col 6, lines 19-36 discloses the following:

FIG. 5 shows an embodiment of a copy control system in digital image distribution using a one-way hash function. In summary, this is a system which prohibits a further copying or recording by appending a token to a broadcasted digital data for controlling copying or recording using an electronic watermarking technique and disabling the token once the data is copied or recorded. While the token may include information as to the manner of controlling data (the number of permitted copies, the number of permitted play-backs, designation of reproducing equipment and designation of a user, etc.) as the CF (control flag) does, it is assumed in FIG. 5 and FIG. 6 that whether data may be copied or not is determined depending on the presence or absence of a token for simplifying the description. Further, the number of tokens may be changed to a desired number depending on the environment of implementation (the number of the tokens may be defined as the limit of the number of copies or play-backs for example).

Examiner maintains that above disclosure by Miwa reads on the claim 12 limitation "wherein the reference database acts as a certification authority."

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Applicant on page 14, discusses the rejection of claims 13, 32 and 58 and repeats the arguments presented when considering claim 1. Examiner is not persuaded by applicant's arguments. Applicant is referred to supra rebuttal of the claim 1 arguments presented by Applicant.

Applicant on page 15, discusses the rejection of claim 16. Examiner is not persuaded by applicant's arguments. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., each and every limitation of the claimed invention.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant on page 15, discusses the rejection of claim 22. Applicant states "Figure 6 of Miwa shows a compare step but gives no indication of 'a means for a user to monitor the comparison device.'" Examiner is not persuaded. Examiner maintains that a user would soon become aware of the failure of the compare step because the user would not be permitted to copy when in fact the user has obtained authorization to copy.

Applicant on page 16, discusses the rejection of claims 29, 38 and 56. Applicant states "Figure 5 does not disclose digitally signing a reference signal before it is embedded and there is no reference in Miwa to the use of a digital signatures as required by Claims 29, 38 and 56."



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Examiner is not persuaded. Examiner is unable to address above because applicant fails to address the claim 27 limitation which recites “wherein the reference signal **abstract** is digitally signed before it is embedded.” However, for sake of completeness, examiner maintains that Miwa’s disclosure in column 2, lines 1-15 reads on above claim limitation.

The electronic watermarking technique exists for the copyright protection of a still image, motion picture and a voice. The electronic watermarking technique is a technique which is also called data hiding (TM). Simply stating, this is a collective name of a technique for embedding certain information in other media (still image, voice and motion picture, etc.) and aims at the way of integrating the information in a medium in which the information is embedded rather than the way of hiding information as used in encryption. In other words, a method is employed for embedding information which is desired to be hidden in the data of a medium by manipulating the data of the medium. This means, in image data for example, information other than the essential data is carried by modifying a pixel value such as the brightness. Incidentally, the term "embed" as used in this invention means that extra information is hidden in the form of modification of the data itself.

Applicant on page 16 discusses the rejection of claims 34 and 39. Applicant states “Miwa discloses using a publicly open key to generate a token on the content side and to prepare an abstract from a distributed token on the user side, but provides no teaching of embedding a key in an abstract.” Examiner is unable to respond because applicant fails to address the claim 34 limitation which states “wherein the abstract is embedded with a predetermined key.” Examiner maintains embedding a key in an abstract is not the same as “wherein the abstract is embedded with a predetermined key.”

Applicant states on page 17 “Applicant submits that the examiner has not satisfied the initial burden of providing ‘clear and particular’ evidence of motivation to combine for any of the proposed combinations of references.” Examiner is not persuaded. In response to

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Applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, examiner maintains that the details of a pay-per-view system are well-known and expected in the art and are generally available to one of ordinary skill in the art.

Applicant states on page 18, "First there is no motivation to combine Miwa with Wong. Wong describes a method for determining if a report request matches a previously generated report; Wong does not discuss the contents of the reports, however." Examiner is not persuaded. Examiner is unable to respond in depth because applicant does not address the limitations of claim 2. Assuming that applicant did address the claim limitations, examiner maintains that a database report is well-known in the art as supported by the disclosure of Wong '058. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wong '058 to include "a database rights and restriction report" per claim 2. The ordinarily skilled artisan would have been motivated to modify Miwa '268 per the above for the purpose of providing an owner with the privileges granted to his/her customers.

Applicant states on page 18, "Second, even if there were motivation, the combination fails to disclose all of the elements of claim 2. [ ..... ] Wong does not disclose the content of the

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reports, and thus, there is no reason to conclude that the referenced report is a 'database rights and restriction report.' Examiner is not persuaded. Examiner maintains the following disclosure by Miwa in column 2 lines 34-39 suggests "a database rights and restriction report."

An example of a data control method using the electronic watermarking technique is given below. Not only in recording, copy and play-back in a place where data is delivered, but also in the broadcasting of data by a radio wave, whether to permit receiving of data or not (receiving control) can be controlled entirely in a similar manner.

Examiner maintains that a database report is well-known in the art as supported by the disclosure of Wong '058. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Wong '058 to include "a database rights and restriction report" per claim 2. The ordinarily skilled artisan would have been motivated to modify Miwa '268 per the above for the purpose of providing an owner with the privileges granted to his/her customers.

Applicant states on page 18, "Claims 41 and 54 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Miwa in view of US Patent No. 6,457,058 issued to Ullum et al (hereafter Ullum). [ ..... ] the examiner refers to a 'known distribution address' whereas the claim requires a 'known distribution status.' The logic of the examiner's rejection of claim 41 makes no sense when applied to a known distribution status.'" Examiner is not persuaded. One of ordinary skill in the art knows that electronic distribution is done on the basis of an address of a desired recipient.

Applicant states on page 19, "Claims 42-48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Miwa and Ullum and further in view of U.S. Patent

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No. 5,920,900 issued to Poole et al (hereafter Poole). As stated for claim 41, there is no motivation to combine Miwa and Ullum. Poole does not cure this deficiency.” In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In this instance examiner provides in supra office action, references from the teaching of Poole why it would have been obvious to one of ordinary skill to combine the references.

### ***Conclusion***

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Etienne (Steve) LeRoux whose telephone number is (703) 305-0620.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic, can be reached at (703) 308-1436.

Any inquiry of a general nature relating to the status of this application or processing procedure should be directed to the receptionist whose telephone number is (703) 305-3900.

Etienne LeRoux

October 16, 2003.



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